

REMARKS

Status of Claims

Claims 1-18 are present for examination.

Prior Art Rejection

Claims 1-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshikawa (6,22,859) in view of Elliott (6,690,654). The Examiner's rejections are respectfully traversed.

The Examiner recognizes that Yohikawa does not teach that the called and calling parties are connected for making the internet service telephone communication utilizing the same ISP network. In order to supply the missing ingredient, the Examiner turns to Elliott and in particular the teaching in column 4, lines 20-33.

This clear from Figure 3 and the description of Yohikawa that there are two internet service providers, namely, ISP-A and ISP-B. In this connection, it is noted that there is a drawing error in Figure 3 of Yohikawa inasmuch as the ISP-B is shown to include an ISP-A terminal adaptor (TA) and ISP-A server. However, according to the description in column 5, lines 30-67, Yohikawa clearly teaches two different ISPs labeled ISP-A and ISP-B and Figure 3 shows these two ISPs in the larger blocks. Thus, the Examiner's understanding of Yohikawa is consistent with that of applicant's, namely, that there is no teaching that the called and calling parties are connected for making the internet service telephone communication utilizing the same ISP network.

Elliott, likewise, does not disclose applicant's recited invention. In column 4, lines 20-33, it is stated as follows:

Network 18 could also comprise other IP-based networks as well as other networks. For example, network 18 could comprise an internet which is not connected to the public Internet. In this context, an "internet" (lowercase "i") is any collection of separate physical networks, interconnected by a common protocol, to form a single logical network. An internet would preferably, but not necessary use Internet Protocol. An internet which is owned by a single entity sometimes referred to as an intranet. Network 18 can comprise an intranet, which is or is not connected to the Internet. For

example, network 18 can be either a public or a carrier supported virtual private network (VPN) or local area network (LAN) which uses IP or IP-tunneling. Other protocols can alternatively be utilized.

As may be seen from the above, Elliott does not supply the missing ingredients wherein a called and calling party are connected together by the same ISP network as recited in applicant's claims. As such, combining Yohikawa with Elliott does not make out a *prima facie* case of obviousness under the provisions of 35 U.S.C. § 103.

In order to expedite further prosecution of the application, applicant has amended the claims in order to emphasize that there is only one ISP being recited in the claims. To make this point clear, applicant has inserted the term "specific" in front of every occurrence of the term ISP or internet service provider. Thus, according to Claim 1, there is provided a specific internet service provider network and a calling party telephone set which is a subscriber to the specific ISP network provides connection point data specific to the specific ISP network for making internet service telephone communication to a called telephone set. The connection point data is provided by using the public telephone network. The call telephone set receives the connection point data from the public network and connects itself to the specific ISP network. In other words, it connects itself to the same specific ISP network to which the calling party is a subscriber. The calling telephone set connects itself to the specific ISP network. Thus, even before the "wherein" clause of Claim 1, both the called and calling parties are connected to the same specific ISP network. The "wherein" clause simply makes this point more explicit in reciting that the called and calling party are connected for making the internet service telephone communication using the same specific ISP network.


By including the word "specific" as a modifier to the ISP network, applicant is emphasizing the fact that the same ISP network is utilized and recited throughout the claims. This is an important point, especially in view of the fact that this limitation is simply not disclosed in the prior art and is certainly not made obvious in view of the combined teachings of Yohikawa and Elliott as cited by the Examiner.

In view of the amendments made hereto and the arguments set forth above, it is submitted that the application is now in condition for allowance and an early indication of same is earnestly solicited.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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